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| 09/808,490      | 03/14/2001  | Brian F. Monahan     | 2001-1              | 3622             |

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EXAMINER

STIMPAK, JOHNNA

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/808,490

**Applicant(s)**

MONAHAN, BRIAN F.

**Examiner**

Johnna R Stimpak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a final office action upon examination of application number 09/808,490. Claims 1-18 are pending and have been examined on the merits discussed below.

#### ***Response to Arguments***

2. Examiner withdraws prior rejections under 35 USC 112, 2<sup>nd</sup> paragraph, to claim 10 based on the amendment.
3. Examiner acknowledges the cancellation of claims 16 and 17 in response to prior rejections.
4. Applicant's arguments filed 3/21/05 have been fully considered but they are not persuasive. Specifically, Applicant argues it would not be obvious to modify d'Eon et al to include modifying marketing communications activity. Examiner respectfully disagrees with this statement. The main objective in d'Eon et al is to determine the effectiveness of Internet advertising. D'Eon et al specifically states activity is correlated to specific advertising banners so it can be ascertained which banners are and are not effective in causing a user to make a transactional decision. It is well known in any type of performance or effectiveness measurement that actions are taken based on the results. For instance, when it is determined in d'Eon et al that a banner is not effective; it would be obvious to take action and remove this under-performing banner. In light of this response, Examiner is upholding prior rejections to claims 1-18 under 35 USC 103(a).
5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, modifying or updating advertising methods is well known within determining effectiveness or performance of advertising methods.

### ***Claim Objections***

6. Claim 18 is objected to because of the following informalities: Claim 18 is dependent on claim 17, which has been cancelled by the most recent amendment. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over d'Eon et al, US 6,006,197.

As per **claim 1**, d'Eon teaches means for selecting marketing communications activity (column 2, lines 45-55); means for collecting performance data of the selected marketing communications activity (column 4, lines 23-34 – the advertisement activity is collected); means

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for processing the marketing communications activity performance data (column 6, lines 16-67 – the data collected is correlated into tables to show the number of impressions associated with each advertisement to indicate effectiveness); means for evaluating processed performance data of all marketing communications activity (column 6, lines 44-67 – data is correlated into tables to show effectiveness of the advertisement), but does not explicitly teach means for reacting to the evaluation by modifying if necessary marketing communications activity. However since d'Eon teaches assessing the effectiveness of Internet advertisements to more efficiently allocate Internet advertising resources, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the evaluation data to modify the marketing activity if needed. For example, d'Eon teaches evaluating the effectiveness based on average revenue value for the advertisement. If it is determined that an advertisement is not generating revenue, it would have been obvious to one of ordinary skill in the art at the time of the invention to cancel an advertisement in order to increase profits.

As per **claim 2**, d'Eon teaches evaluating the processed performance data of marketing communications activity comprises evaluation relative to the expected contribution of marketing communications to the business objectives of the business enterprise (column 7, lines 7-14 – columns are displayed showing average revenue generated from each advertisement).

As per **claim 3**, d'Eon teaches the marketing communications activity comprises functions and associated financial costs thereof comprising printed or electromagnetic-based media (column 3, lines 7-16 – advertising cost information is included in the evaluation of the advertising).

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As per **claim 4**, d'Eon teaches the processing of marketing communications activity data further comprises historical performance data (column 4, lines 23-34 and column 5, lines 35-67 – the performance data of the advertisement is collected through tracking).

As per **claim 5**, d'Eon teaches the media comprises the Internet (column 4, lines 23-34 – the system collects information on Internet advertising through the World Wide Web).

As per **claim 6**, d'Eon teaches the marketing communications activity data is collected by manual, electronic or telephonic monitoring means (column 4, lines 23-34 – the data is collected electronically - the system collects information on Internet advertising through the World Wide Web

As per **claim 7**, d'Eon teaches the data processing integrates varied data sources and comprises a reporting interface means (column 6, lines 44-55 – the resulting outcome is output via, e.g., the monitor, printer or some other output device).

As per **claim 8**, d'Eon teaches the data sources comprise media contracts, media delivery information, survey information, call center volume, store foot traffic, sales scanner data, focus group responses or web site traffic or combination thereof (column 4, lines 24-34 – collects web site traffic).

As per **claim 9**, d'Eon teaches the data is maintained in a centralized database, multiple databases, or combination thereof (column 4, lines 24-34 – the tracking software collects the information and as shown in figure 1, it is stored in a computer database).

As per **claim 10 (currently amended)**, d'Eon teaches the business objectives comprise customer acquisition, customer retention, branding, intellectual property acquisition, conversion, insight, development of international business relationships or customer bases, increased

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revenues, diversification of products or services, increased profits, personnel recruitment, or public relations or combination thereof (column 7, lines 7-14 – columns are displayed showing average revenue generated from each advertisement).

As per **claim 11**, d'Eon teaches the rapid response marketing system is maintained on an ongoing basis (column 4, lines 23-34 – each time the advertisement is clicked by a user, the tracking software collects information).

As per **claim 12**, d'Eon teaches the reacting to the evaluation of marketing communications activity involves no modification, or modification of marketing activity by increasing or decreasing some or all of marketing communications activities, deleting selected activities, adding new marketing activities, or altering the messaging of selected marketing communications activity (column 1, lines 45-55 – the overall goal of the d'Eon reference is to determine which advertising campaigns are effective therefore it is inherent to d'Eon that the evaluation data is used to determine if an advertising activity should be modified, deleted or if a new activity should be added).

As per **claim 13**, teaches identifying the expected contribution of marketing communications to the business objectives of the business enterprise (column 7, lines 7-14 – columns are displayed showing average revenue generated from each advertisement); identifying industry marketing communications information, past and current marketing communications activities and history thereof, if any, of the business enterprise (column 6, lines 44-55 – each advertisement activity is associated with the number of impressions collected to determine effectiveness); selecting a means for monitoring the marketing tools on an ongoing basis (column 4, lines 23-34 – each time the advertisement is clicked by a user, the tracking software

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collects information); selecting means for reacting to the evaluation of the marketing communications performance (column 1, lines 45-55 – the overall goal of the d'Eon reference is to determine which advertising campaigns are effective therefore it is inherent to d'Eon that the evaluation data is used to determine if an advertising activity should be modified, deleted or if a new activity should be added); implementing the continuously interactive marketing system.

D'Eon teaches evaluating the effectiveness of an Internet marketing campaign to determine which advertising efforts are effective and also teaches the effectiveness of an advertisement is based on revenue. Although d'Eon does not explicitly teach identifying performance metrics of the marketing communications comprising a performance model or standards to measure accomplishment of the business objectives; identifying available interactive marketing tools; selecting a marketing communication strategy comprising selecting marketing tools of the business enterprise or available interactive marketing tools sufficient to accomplish the expected contribution of marketing communications to the business objectives of the business enterprise; selecting a means for evaluating on an ongoing basis the identified performance metrics, these are well known methods used in the art of evaluating marketing strategies. D'Eon doesn't explicitly teach metrics to evaluate accomplishment of business objectives, but it would have been obvious to set forth a metric or standard to strive for in order to make the determination of effectiveness less subjective. For example, if an advertisement doesn't generate a certain amount of revenue, it is cut. D'Eon also doesn't explicitly teach identifying available tools and selecting based on business objectives, since d'Eon is concerned with evaluating current advertising efforts and determining if they are effective it would have been obvious to identify other available advertisements to meet business objectives to use in the



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case that an ad was found to be ineffective, after all the overall goal of d'Eon is to find the most effective advertisement to generate the most revenue.

As per **claim 14 (currently amended)**, d'Eon et al teaches selecting marketing communications activity (column 2, lines 45-55); collecting performance data of the selected marketing communications activity (column 4, lines 23-34 – the advertisement activity is collected); processing the marketing communications activity performance activity (column 6, lines 16-67 – the data collected is correlated into tables to show the number of impressions associated with each advertisement to indicate effectiveness); evaluating the processed performance data of all marketing communications activity (column 6, lines 44-67 – data is correlated into tables to show effectiveness of the advertisement), but does not explicitly teach reacting to the evaluation by modifying if necessary marketing communications activity. However since d'Eon teaches assessing the effectiveness of Internet advertisements to more efficiently allocate Internet advertising resources, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the evaluation data to modify the marketing activity if needed. For example, d'Eon teaches evaluating the effectiveness based on average revenue value for the advertisement. If it is determined that an advertisement is not generating revenue, it would have been obvious to one of ordinary skill in the art at the time of the invention to cancel an advertisement in order to increase profits.

As per **claim 15**, d'Eon teaches the evaluating of the performance data of marketing communications activity comprises evaluating relative to the expected contribution of marketing communications to the business objectives of the business enterprise (column 7, lines 7-14 –

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columns are displayed showing average revenue generated from each advertisement – the evaluation of the advertisement is based on the monetary contribution of the advertisement).

As per **claim 16 (cancelled)**

As per **claim 17 (cancelled)**

As per **claim 18**, d'Eon teaches the evaluating of the performance data of marketing communications activity comprises evaluating relative to the expected contribution of marketing communications to the business objectives of the business enterprise (column 7, lines 7-14 – columns are displayed showing average revenue generated from each advertisement – the evaluation of the advertisement is based on the monetary contribution of the advertisement).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Beck et al, US 6,026,371 – method and apparatus for allowing online directory producers to preview advertisement in online directory listings

Cannon, US 6,286,005 – method and apparatus for analyzing data and advertising optimization

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R Stimpak whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS  
6/01/05



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